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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,540	11/14/2001	Jose Costa Requena	944-001.035-1	2990

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WARE FRESSOLA VAN DER SLUYS &
ADOLPHSON, LLP
BRADFORD GREEN BUILDING 5
755 MAIN STREET, P O BOX 224
MONROE, CT 06468

EXAMINER

MOLINARI, MICHAEL J

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,540

Applicant(s)

REQUENA, JOSE COSTA

Examiner

Michael J Molinari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5-9.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 6, 8, 11, 13, 16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Hundscheidt (U.S. Patent No. 6,757,266).
3. Referring to claim 1, Hundscheidt discloses a method, comprising the steps of: receiving signaling provided by an application-layer control protocol (SIP, see Table 2, columns 11 and 12, and see column 12, lines 48-67) from a terminal (TE1-TE3, see Figure 1a) of a packet data network (TCP/IP Network, see Figure 1a) at an interface (GAS, or Gateway Access Server, see Figure 1a) between the packet data network and a circuit-switched network (PLMN, see Figure 1a), and converting the signaling from the terminal at the interface (see column 10, lines 45-50), for providing signaling in a protocol used in the circuit-switched network for enabling the terminal to access one or more services of the circuit-switched network (see column 10, lines 45-50).
4. Referring to claim 3, Hundscheidt discloses that the application-layer control protocol is a session initiation protocol (SIP) (see Table 2, columns 11 and 12, and see column 12, lines 48-

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67) and the circuit-switched network comprises, at least in part, a public land mobile network (PLMN) (see column 7, lines 50-60).

5. Referring to claim 6, Hundscheidt discloses a method, comprising the steps of: providing signaling according to an application-layer protocol (SIP, see Table 2, columns 11 and 12, and see column 12, lines 48-67) from a terminal (TE1-TE3, see Figure 1a) of a packet data network (TCP/IP Network, see Figure 1a) to an interface (GAS, or Gateway Access Server, see Figure 1a) between the packet data network and a circuit-switched network (PLMN, see Figure 1a), wherein the interface is for converting the signaling from the terminal for providing signaling in a protocol used in the circuit-switched network for enabling the terminal to access one or more services of the circuit-switched network, and receiving signaling from the interface according to the application-layer control protocol at the terminal of the packet data network indicative of a communication setup between the terminal and the packet data network and said one or more services of the circuit-switched network (see column 10, lines 45-50 and see Figure 1b).

6. Referring to claim 8, Hundscheidt discloses that the application-layer control protocol is a session initiation protocol (SIP) (see Table 2, columns 11 and 12, and see column 12, lines 48-67) and the circuit-switched network comprises, at least in part, a public land mobile network (PLMN) (see column 7, lines 50-60).

7. Referring to claim 11, Hundscheidt discloses an interface (GAS, or Gateway Access Server, see Figure 1a), comprising: means for converting signaling provided by an application-layer control protocol (SIP, see Table 2, columns 11 and 12, and see column 12, lines 48-67) from a terminal (TE1-TE3, see Figure 1a) of a packet data network (TCP/IP Network, see Figure 1a) to a protocol used in a circuit-switched network (PLMN, see Figure 1a) for enabling the

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terminal to access one or more services of the circuit-switched network (see column 10, lines 45-50); and means for converting signaling provided by the circuit-switched network in the protocol used in the circuit-switched network to signaling for the application-layer control protocol used in the terminal of the packet data network for said enabling the terminal to access one or more services of the circuit-switched network (see column 10, lines 45-50 and see Figure 1b).

8. Referring to claim 13, Hundscheidt discloses that the application-layer control protocol is a session initiation protocol (SIP) (see Table 2, columns 11 and 12, and see column 12, lines 48-67) and the circuit-switched network comprises, at least in part, a public land mobile network (PLMN) (see column 7, lines 50-60).

9. Referring to claim 16, Hundscheidt discloses a terminal (TE1-TE3, see Figure 1a) of a packet data network (TCP/IP Network, see Figure 1a), comprising: transmitting means for providing signaling according to an application-layer protocol (SIP, see Table 2, columns 11 and 12, and see column 12, lines 48-67) of the packet data network to an interface (GAS, or Gateway Access Server, see Figure 1a) between the packet data network and a circuit-switched network (PLMN, see Figure 1a), wherein the interface is for converting the signaling from the transmitting means for providing signaling in a protocol used in the circuit-switched network for enabling the terminal of the packet data network to access one or more services of the circuit-switched network (see column 10, lines 45-50); and receiving means for receiving signaling from the interface according to the application-layer control protocol of the packet data network indicative of a communication setup between the terminal and the circuit-switched network for accessing said one or more services of the circuit-switched network (see column 10, lines 45-50 and see Figure 1b).

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10. Referring to claim 18, Hundscheidt discloses that the application-layer control protocol is a session initiation protocol (SIP) (see Table 2, columns 11 and 12, and see column 12, lines 48-67) and the circuit-switched network comprises, at least in part, a public land mobile network (PLMN) (see column 7, lines 50-60).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 7, 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hundscheidt (U.S. Patent No. 6,757,266) in view of Handley et al. ("SIP: Session Initiation Protocol").

13. Referring to claims 2, 7, 12, and 17, Hundscheidt discloses that the signaling from the terminal is for enabling access to a roaming service available in the circuit-switched network comprising, at least in part, a public land mobile network (PLMN) (see column 7, lines 50-60), but differ from claim 2 in that they fail to disclose that the signaling from the terminal is for indicative of a private user identification of the terminal. However, it is well known in the art that SIP request and response messages (such as the SETUP message of Hundscheidt) must contain a From general-header field, which identifies the private user identification of the terminal. For example, Handley et al. ("SIP: Session Initiation Protocol") teach just such a requirement (see Section 6.24, pages 48 and 49). One with skill in the art would have recognized

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the necessity of including a From general-header field as taught by Handley et al. ("SIP: Session Initiation Protocol"). Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate the use of a From general-header field as taught by Handley et al. ("SIP: Session Initiation Protocol") into the invention of Hundscheidt to achieve the advantage of incorporating a required general-header field in SIP as defined by the IETF.

14. Claims 4, 5, 9, 10, 14, 15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hundscheidt (U.S. Patent No. 6,757,266) in view of Handley et al. ("RFC 2327").

15. Referring to claims 4, 9, 14, and 19, Hundscheidt discloses enabling access to a roaming service of the PLMN for use by the terminal of the packet data network (see column 7, lines 50-60 and see column 8, lines 6-24) but differ from claim 4 in that they fail to disclose that said step of receiving includes the step of receiving a session description protocol (SDP) within the SIP to indicate a private user identification of the terminal. However, it is old and well known in the art to use SDP with SIP to achieve the advantage of using a protocol that is intended to be used with SIP for session invitation, such as in the SETUP message of Hundscheidt, and that SDP contains a field called Origin which identifies the originator of the session. For example, Handley et al. ("RFC 2327") teach just such a field (see page 7), which has the advantage of being a standard field in SDP. One skilled in the art would have recognized the advantage of using the Origin field in SDP to identify a private user identification of the terminal as taught by Handley et al. ("RFC 2327"). Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate the use of the Origin field in SDP as taught by Handley

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et al. ("RFC 2327") into the invention of Hundscheidt to achieve the advantage of using an advantageous protocol with SIP for session invitation and of using a standard field in SDP.

16. Referring to claims 5, 10, 15, and 20, Hundscheidt discloses enabling access to a roaming service available in the circuit-switched network comprising, at least in part, a public land mobile network (PLMN) for use by the terminal of the packet data network (see column 7, lines 50-60 and see column 8, lines 6-24), but differ from claim 5 in that they fail to disclose that said step of receiving includes the step of receiving a session description protocol (SDP) within the SIP to indicate a private user identification of the terminal. However, it is old and well known in the art to use SDP with SIP to achieve the advantage of using a protocol that is intended to be used with SIP for session invitation, such as in the SETUP message of Hundscheidt, and that SDP contains a field called Origin which identifies the originator of the session. For example, Handley et al. ("RFC 2327") teach just such a field (see page 7), which has the advantage of being a standard field in SDP. One skilled in the art would have recognized the advantage of using the Origin field in SDP to identify a private user identification of the terminal as taught by Handley et al. ("RFC 2327"). Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate the use of the Origin field in SDP as taught by Handley et al. ("RFC 2327") into the invention of Hundscheidt to achieve the advantage of using an advantageous protocol with SIP for session invitation and of using a standard field in SDP.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Molinari whose telephone number is (703) 305-5742. The examiner can normally be reached on Monday-Thursday 8am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on (703) 308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mjm

Michael Joseph Molinari

**DUCHO
PRIMARY EXAMINER**

Suehwa
7-9-04